

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA SOURIS

Appeal No. 99-1010
Application 29/062,011¹

ON BRIEF

Before THOMAS, STAAB, and OWENS, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the examiner's
final rejection of the only claim pending:

The ornamental design of a hanging flower pot as
shown and described.

¹ Application for patent filed November 5, 1996. According to
appellant, this application is a continuation of Application 29/035,965,
filed March 10, 1995 (abandoned).

Appeal No. 99-1010
Application 29/062,011

The examiner has relied upon the following reference:

Gardner, The Glass of Frederick Carder, Crown Publishers, Inc., New York, "Plate XXIII, B, Mandarin yellow Group" (copyright 1971)[hereinafter Carder]

The claim stands rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Carder alone.

We refer to the brief and the answer for the respective positions of the appellant and the examiner.

OPINION

"In determining the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which must be taken into consideration." See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982). Where the inquiry is to be made under 35 U.S.C. § 103, the proper standard is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See

Appeal No. 99-1010
Application 29/062,011

In re Nalbandian, 661 F.2d 1214, 1217, 211 USPQ 782, 785 (CCPA 1981). Furthermore, as a starting point for a § 103 rejection, there must be a reference, a "something in existence," the design characteristics of which are basically the same as the claimed design:

Thus there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design in order to support a holding of obviousness. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references.

Rosen at 673 F.2d 391, 213 USPQ 350.

We reverse the outstanding rejection of the pending design claim on appeal because the examiner's position is flawed in several major respects.

According to one line of reasoning, the examiner appears to give no patentable weight to or effectively reads out of the claimed invention the four holes around the neck portion and the opening in the bottom of the claimed hanging flower

Appeal No. 99-1010
Application 29/062,011

pot since these features are characterized as being functional within

35 U.S.C. § 171. Inasmuch as there is no outstanding rejection before us of the design claim on appeal on functionality grounds, the examiner's reasoning is misplaced. Moreover, the examiner's reasoning as to this improper approach does not assert that the design as a whole was primarily functional.

As to these same two aspects of the claimed design, the examiner admits that the Carder vase does not teach or show either of them. At the bottom of page 3 of the answer, the examiner states that "with only a single perspective view of the Carder vase to rely upon, the exact shape of the vase cannot be determined as could be done with additional elevational or sectional views." Similarly, the examiner admits at the top of page 4 that "Carder does not disclose the four small circular openings that are equally spaced around the upper portion of the neck, nor does it disclose an opening in the base of the vase." On the basis of these admissions, and in view of the fact that no additional prior art has been

Appeal No. 99-1010
Application 29/062,011

relied upon, we are constrained to reverse the outstanding rejection under 35 U.S.C. § 103.

Although we would tend to agree with the examiner's view that the four holes in the neck portion may be characterized as de minimus in context of the overall design as a whole when taken in light of the similar neck portion in Carder, the examiner's recognition that the base portion of the claimed hanging flower pot is not taught or suggested at all in the prior art cannot be rationalized away. At page 6 of the answer the examiner asserts that this opening in the base portion of the claimed hanging flower pot would have been obvious because "this is a typical circular hole in the base of a flower pot, standard in the art of flower containers." This approach is also fatal to the examiner's position. According to a utility application standard for obviousness, we observe that the examiner's rationale may have merit. However, in a design application context such general design concepts are inappropriate. The examiner's evidentiary void can not be filled by a conceptualized approach. We have no indication, that is, no

Appeal No. 99-1010
Application 29/062,011

evidence before us as to the shape or size or configuration or whatever of such a conceptualized, known in the art circular hole for flower pots.

Such an approach has been highly disfavored in accordance with the court's reasoning in In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993).

As a matter of law and practice and procedure, the examiner's rejection cannot be sustained. Therefore, the decision of the examiner rejecting the design claim on appeal under 35 U.S.C. § 103 is reversed.

REVERSED

	James D. Thomas)	
	Administrative Patent Judge)	
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)	
)	
	Lawrence J. Staab)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Terry J. Owens)	
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Daniel P. Burke

Appeal No. 99-1010
Application 29/062,011

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